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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,965	01/12/2001	Matthew Thomas Heisey	8398	1681

27752 7590 01/30/2002

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EXAMINER

CRANE, LAWRENCE E

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 01/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/759,965</b>	Applicant(s) <b>Heisey et al.</b>	
	Examiner <b>L. E. Crane</b>	Group Art Unit <b>1627</b>	

**- THE MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **--3--** MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be filed after six months from the date of this communication.
- If the prior for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 USC §133).

## Status

- ☒ Responsive to communication(s) filed on **-06/13/01 (IDS)-**.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claims **--1-50--** are pending in the application. Claims **-[]-** have been cancelled.
- Of the above claim(s) **--[]--** is/are withdrawn from consideration.
- ☐ Claim(s) **--[]--** is/are allowed.
- ☒ Claims **--1-50--** are rejected.
- ☐ Claim(s) **--[]--** is/are objected to.
- ☐ Claim(s) **--[]--** are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on **-[]-** are ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on **-[]-** is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119(a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) **-[]-**.
- ☐ received in the national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: **-[]-**.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). **--07--**
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other: **-[]-**

U.S. Patent Trademark Office

## Office Action Summary

PTO-326 (Rev. 06/19/01)  
S. N. 09/759,965

Copy for ☒ FILE ☐ APPLICANT

Part of Paper No. **08**

Art Unit 1627

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1600, Art Unit 1627.

5       No claims have been cancelled and no preliminary amendments filed as of the date of the instant Office action. An Information Disclosure Statement (IDS) filed June 13, 2001 has been received with all cited references and made of record.

Claims 1-50 remain in the case.

10       35 U.S.C. §101 reads as follows:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”

15       Claims 43-46 are rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. ,1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149, 149 USPQ 475 (D.D.C. 20 1966).

25       Claims 1-15, 22-36 and 43-46 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In claims 1, 13, 22 and 34 the terms "gelatin," "cartilage," "amino sugars," and "glycosaminoglycans" are directed to a vast array of compounds only a few of which are known to have the desired beneficial effects claims. The remainder of the specific compounds included  
5 within the generic terms noted are not properly enabled by the instant written description and are therefore not properly enabled.

Claims 1, 5-6, 13, 17-18, 22 and 34 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly  
10 point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 13, 22 and 34 the term "precursors" is indefinite for failure to specify which particular compounds are being claimed as active ingredients.

In claims 1, 13, 22 and 34 in section "b)", the term "other than" is  
15 an improper negative limitation because said term fails to affirmatively designate the subject matter being claimed.

Claims 5 and 6 are improperly dependent because said claims include subject matter specifically excluded from claim 1. This problem is not cured by the term "further comprising." See also claims 17 and  
20 18.

In claims 13 and 34, last line, the term "substantially" is per se indefinite and its deletion is respectfully requested.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially  
25 created doctrine grounded in public policy (a policy reflected in the

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statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F. 2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. §1.78(d).

Effective January 1, 1994, a registered attorney or agent or record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. §3.73(b).

Claims 1-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/760,280. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treatment and the alleged active ingredients of the claimed compositions are directed to substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/586,520. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the methods of treatment and the alleged active ingredients of the claimed compositions are directed to substantially overlapping subject matter.

5 This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10 Claims 1-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 09/586,284. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treatment and the alleged active ingredients of the claimed compositions are directed to substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15 Claims 1-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/586,514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treatment and the alleged active ingredients of the claimed compositions are directed to substantially overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

25 Claims 1-50 of this application conflict with claims of four other patent applications noted supra. 37 C.F.R. §1.78(b ) provides that when two or more applications filed by the same applicant contain conflicting

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claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or  
5 maintain a clear line of demarcation between the applications. See MPEP §822.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

15 Claims 1-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over PTO-1449 references AB, AC, AE, AK, AN, AP, AU, AW, AZ, BA, BD, BE, BF, BG, BL, CA and CB and PTO-892 references A, R, S and T wherein the ingredients listed as active are repeatedly disclosed as being known in the art as appropriate constituents of joint  
20 assisting food composition.

In light of applicant's failure to provide any data to support an unexpected benefit from the instant claimed compositions, the instant claimed compositions, kits thereof and methods of administration thereof, are deemed to lack patentable distinction as being nothing more  
25 than a mixture of substances known in the prior art and therefore obvious compositions to be administered to a host in need thereof. Any compounds (e.g. sweeteners) not specifically found in the instant cited references are certainly known in the prior art and may be found in standard texts on pharmacology and/or food additives.

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Therefore, the instant claimed compositions, kits and methods of administration would have been obvious to one of ordinary skill in the art having the above cited reference before him at the time the invention was made.

5        This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under  
10    37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103(a).

15        Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are **(703) 308-4556** and **703-305-3592**.

20        Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **703-308-4639**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

25        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist, can be reached at (703)-308-1701.

Serial No. 09/759,965

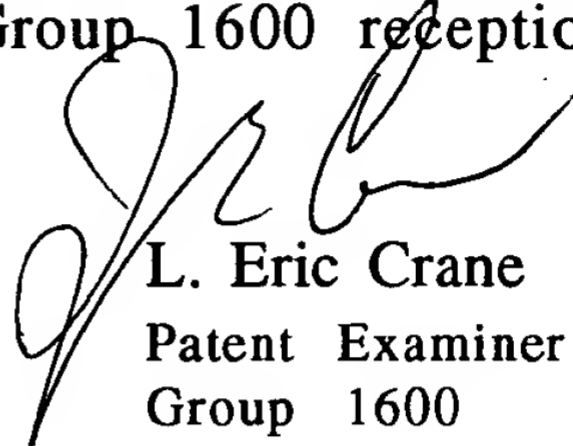
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Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is 703-308-1235.

LECrane:lec

5 01/28/02



L. Eric Crane  
Patent Examiner  
Group 1600